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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,486	03/08/2007	Yuhwa Lo	UCSD-32767-A-US	9679

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EXAMINER

THOMPSON, TIMOTHY J

ART UNIT	PAPER NUMBER
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2873

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06/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,486	Applicant(s) LO ET AL.	
	Examiner TIMOTHY J. THOMPSON	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21, 23-28, 30-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 7, 12-21, 23-28, 30-33 and 35 is/are allowed.
- 6) ☒ Claim(s) 3-6, 8-11, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/27/2008</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3-5, 8, 9, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floyd(U.S. Pat. Pub. No. 2003/0095336) in view of Lee(U.S. Pat. No. 7,367,550).

Regarding claim 3, 36, Floyd discloses a first partition that is flexible and optically transparent(fig 1, 21); a second partition that is coupled to the first partition(fig 1, 33), wherein at least a portion of the second partition is optically transparent, and wherein a first cavity is formed in between the first partition and the second partition(fig 1); a first fluidic medium positioned within the cavity, the fluidic medium also being optically transparent(fig 1, 23); and a first component capable of controlling a parameter of the fluidic medium, wherein when the parameter of the fluidic medium changes, the first partition flexes and an optical property of the lens is varied(fig 8); the first partition is a flexible membrane formed from at least one of a thin plastic polymer and a flexible, optically transparent material(para 0058). Floyd does not disclose wherein the first partition is formed from polydimethylsiloxane. However, Lee discloses a deflectable portion of a wall is made from polydimethylsiloxane. Since all the

Art Unit: 2873

known elements would continue to operate in the same manner, specifically the lens device would still have a flexible partition wall allowing the fluidic medium to enter the chamber expanding the flexible wall. Therefor the results would be predictable to one of ordinary skill in the art. As such it would have been obvious to one of ordinary skill in the art to use polydimethylsiloxane for the first partition as shown by Lee with the fluidic lens of Floyd as being no more “than the predictable use of prior-art elements according to their established functions”.

KSR international v. Teleflex inc.(2007).

Regarding claim 4, Floyd discloses wherein the second partition is a ring partition formed from at least one of a plastic and a material that is at least partly optically transparent.(fig 1, and para 0054).

Regarding claim 5, Floyd discloses wherein the second partition includes at least one channel allowing for the first fluidic medium to at least one of enter and exit the cavity(fig 1, 67, 69).

Regarding claim 8, Floyd discloses wherein a first side of the flexible membrane is adjacent to the first fluidic medium and a second side of the flexible membrane is adjacent to a second fluidic medium(fig 1, the chamber facing 53).

Regarding claim 9, Floyd discloses wherein the second fluidic medium is air from the atmosphere(para 0075 since a water tight seal is used to prevent water from leaking in and not other material is added to the chamber, the chamber inherently has air within the chamber).

Regarding claim 37, Floyd discloses wherein the adjusting of the fluid pressure causes at least one of a change in a focal distance and a change in lens type(para 0078).

Claim 3, 4, 6, 8, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silver(GB 2184562 A) in view of Lee(U.S. Pat. No. 7,367,550).

Regarding claim 3, Silver discloses a first partition that is flexible and optically transparent(fig 2, 1); a second partition that is coupled to the first partition(fig 2, 6), wherein at least a portion of the second partition is optically transparent, and wherein a first cavity is formed in between the first partition and the second partition(fig 1); a first fluidic medium positioned within the cavity, the fluidic medium also being optically transparent(pg 1, lines 25-35); and a first component capable of controlling a parameter of the fluidic medium, wherein when the parameter of the fluidic medium changes, the first partition flexes and an optical property of the lens is varied(pg 2, 20-30); the first partition is a flexible membrane formed from at least one of a thin plastic polymer and a flexible, optically transparent material(pg 1, lines 110-115). Silver does not disclose wherein the first partition is formed from polydimethylsiloxane. However, Lee discloses a deflectable portion of a wall is made from polydimethylsiloxane. Since all the known elements would continue to operate in the same manner, specifically the lens device would still have a flexible partition wall allowing the fluidic medium to enter the chamber expanding the flexible wall. Therefor the

Art Unit: 2873

results would be predictable to one of ordinary skill in the art. As such it would have been obvious to one of ordinary skill in the art to use polydimethylsiloxane for the first partition as shown by Lee with the fluidic lens of Floyd as being no more “than the predictable use of prior-art elements according to their established functions”. *KSR international v. Teleflex inc.*(2007).

Regarding claim 4, Silver discloses the second partition is a ring partition formed from at least one of a plastic and a material that is at least partly optically transparent(pg 1, 110-130).

Regarding claim 6, Silver discloses the second partition includes a first portion that extends substantially parallel to the first partition when the first partition is in an unflexed position and also includes a second portion that extends substantially perpendicularly to the first portion(fig 2).

Regarding claim 8, Silver discloses a first side of the flexible membrane is adjacent to the first fluidic medium and a second side of the flexible membrane is adjacent to a second fluidic medium(fig 2).

Regarding claim 10, Silver discloses a third partition that is coupled to at least one of the first partition, the second partition, and an intermediate structure that is coupled to at least one of the first partition and the second partition(fig 2, 17,19).

Regarding claim 11, Silver discloses a second cavity is formed in between the third partition and the first partition, wherein the first partition extends substantially in between the second and third partitions, and wherein the second fluidic medium is positioned within the second cavity (fig 2, 20).

Allowable Subject Matter

Claims 2, 7, 12-21, 23-28, 30-33, 35 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art taken either singularity or in combination fails to anticipate or fairly suggest the limitations of the independent claim, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claims 7, 12, 14, 25, 35, 36, with the allowable features being; wherein the cavity is substantially cylindrical, the second portion forms a substantially cylindrical wall around the cavity, and the first partition and the first portion of the second partition respectively form first and second cylinder end walls of the cavity(claim 7); a second component capable of controlling a second parameter of the second fluidic medium(claim 12); a fourth partition that is coupled to the third partition, wherein a third cavity is formed in between the third partition and the fourth partition(claim 14); wherein at least one parameter of each of the at least one fluidic medium is controllable by at least one of means for providing fluid flow and means for varying fluid pressure(claim 25); manner that substantially encloses the second cavity, wherein the second structure includes the second cavity and a third cavity(claim 35). Therefore claims 2, 12-21, 23-28, 30-33, 35 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments filed 4/07/2009 have been fully considered but they are not persuasive. Regarding the applicant's argument that using Lee as a reference to the polydimethylsiloxane for the first flexible partition is out side the analogous art. KSR trumps this passage. KSR has basically ruled that you are not limited to analogous art. The Patent Office has taken this position and I have been in several meeting where this has been explained to me. I have been told that if the Office of Quality Management pulls my case, and art outside of analogous art is found, this will be considered an error on my part. Additionally, it has been ruled that patents are not granted based upon using known materials as ruled by *In re Leshin* 125 USPQ 416. Thus using non analogous art is permissible, however, even if it wasn't the claim would still not be allowable simply because of a known material used for the flexible membrane.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

Art Unit: 2873

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY J. THOMPSON whose telephone number is (571)272-2342. The examiner can normally be reached on 8:30 AM - 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mack Ricky can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2873

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J Thompson/
Primary Examiner, Art Unit 2873